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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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BELL, BOYD & LLOYD LLC
P. O. BOX 1135
CHICAGO, IL 60690-1135

EXAMINER

HENDRICKS, KEITH D

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/936,672

Applicant(s)

CUPP ET AL.

Examiner

Keith Hendricks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

- It is noted that the first line of the specification states that this application "is a Continuation-in-Part of U.S. Patent Application Serial No. 09/154,646 filed September 17, 1998, while the oath/declaration only refers to 09/483,328, filed January 14, 2000 and to the PCT filed January 10, 2001. Thus, it is unclear from which date(s) applicant intends to claim priority. Clarification and correction of the specification and/or a new oath, are requested.
- It is noted that this application claims priority to PCT/EP01/00307 and US application 09/483,328. However, it is noted that the subject matter of claims 21-35 does not find support in the 09/483,328 application, and thus *the effective priority date for the subject matter of claims 21-35, is January 10, 2001, the filing date of PCT/EP01/00307.*

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

i) Claims 7-12, 18, 28-29 and 34-35 remain rejected under 35 U.S.C. 102(b) as being anticipated by Gellman et al. (US PAT 4,743,460). The reference and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed April 26, 2004, have been fully considered but they are not persuasive. At page 6 of the response, applicant states that

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Each of the claims requires that the product includes insoluble fiber. Gellman fails to disclose or suggest a product including insoluble fiber. The fact that Gellman suggests a product including fiber does not mean that the product includes insoluble fiber. Anticipation requires more than just probabilities.

This is not deemed persuasive for the reasons of record. Again, as specifically addressed in the previous Office actions, insoluble fiber is not specifically mentioned by name as an ingredient in Gellman et al.; however, the farinaceous materials described at column 10 naturally contain some amount of fiber. Simply because a sub-component of a composition element is not specifically recited by name, does not in any way mean that it is not present. The reference cannot possibly itemize each and every sub-component of each ingredient present in a composition, for example, including the names of each amino acid, or each mineral, or the fact that fiber is naturally present in the component which is recited as present. There is no need for this, and it does not make it any less accurate. As previously stated on the record, for example, wheat generally contains 2.3- 5.6% total dietary fiber, with 1.7% of that insoluble, including cellulose. Corn flour has 15% insoluble fiber, including cellulose (reference to standard textbook in the art, for example, pg. 481, 484. Lorenz et al. "Handbook of Cereal Science and Technology", Dekker Press, 1991). Thus, the referenced products which are taught as containing these components, *necessarily* contain insoluble fiber as a result of inclusion of these components. Note that the instantly-rejected claims simply require the *presence* of insoluble fiber, in any amount. Further, applicant has not addressed the specific data provided on the record regarding this factor.

Again, Gellman et al. disclose a dry soft canine biscuit comprising a denatured/gelled protein source and carbohydrate source (farinaceous and/or vegetable material), with insoluble fiber, and optionally about 5-15% of a humectant, including glycerin (abstract; col.'s 7-8). The denaturation and gelling is formed from the heat during extrusion. The final biscuit pieces have a moisture content of "less than or equal to about 15 percent by weight and preferably about 10 to about 12 percent by weight" (col. 9, lines 39-43). The final canine biscuit product has a preferred thickness of about 1/2 inch [12.7 mm] (col. 5, line 28), and was cut into 1.25 inch (31.75 mm) length cylinders (col. 13, line 40). At column 12, the reference states that when the composition contains vegetable protein to replace some or all of the meat protein, the product will have "a bulk density of about 15 to about 20 lbs. per cubic foot". Insoluble fiber is not specifically mentioned as an ingredient; however, the farinaceous materials described at column 10 naturally contain some amount of fiber. For example, wheat generally contains 2.3- 5.6% total dietary fiber, with 1.7% of that insoluble, including cellulose. Corn flour has 15% insoluble fiber, including cellulose (reference to standard textbook in the art, for example, pg. 481, 484. Lorenz et al. "Handbook of Cereal Science and Technology", Dekker Press, 1991). Although this does not reach the

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threshold of "about 2% to about 15%" (instant claims 4, 10, and 16), the instantly-rejected claims are anticipated by the reference. Note that as the reference teaches the optional use of the humectant, this reads upon the instant claims, "wherein the product does not include a humectant."

ii) Claims 1-20, 21, 26, 29, 32 and 35 remain rejected under 35 U.S.C. 102(b) as being anticipated by Hand et al. (US PAT 5,431,927). The reference and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed April 26, 2004, have been fully considered but they are not persuasive. At page 6 of the response, applicant states that "Hand discloses a product that preferably has a density of 20-30 lbs/ft³... As amended, the claims require a density of not greater than 20 lbs/ft³. Thus, as amended, Hand teaches away from the claimed invention as the preferred density is greater than 20 lbs/ft³."

This is not deemed persuasive for the reasons of record. Applicant's stated interpretation of the teachings of the reference is inaccurate and misleading. Initially, the reference is applied under 35 U.S.C. 102(b), such that it anticipates the claimed invention, and thus there is no applicable question of "teaching away", as may be considered under the statute of 35 U.S.C. 103(a). Secondly, both the reference and the claims disclose a density encompassing 20 lbs/ft³, as this is an exact overlapping endpoint for both the claimed range and the referenced range. Applicant's further statement that "Hand fails to disclose other claimed elements" is unsupported and not deemed persuasive for the reasons set forth previously on the record, which demonstrate that each and every element of the claims has been anticipated by the reference. Applicant's argument fails to comply with 37 CFR 1.111(b) because it amounts to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Furthermore, applicant has not addressed the statement on the record regarding the teaching of Hand et al. spanning columns 5-6, where it is taught that "the dried pellets have a density in the range of about 10 to about 35 lbs/ft³." Thus, applicant's claims are anticipated by the reference.

iii) Claims 21, 24-25, 27-28, 30-31 and 33-34 remain rejected under 35 U.S.C. 102(e) as being anticipated by Wang (US PAT 6,455,083). The reference and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed April 26, 2004, have been fully considered but they are not persuasive. At page 6 of the response, applicant states that the grounds upon which the reference has

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been applied are "incorrect as a matter of law," and that "it is improper to reject a dependent claim as lacking novelty or obviousness if the independent claim is not so rejected."

This is not deemed persuasive for the reasons of record. As previously explained on the record, the subject matter of claims 21-35 does not find support in the parent 09/483,328 application, filed January 14, 2000 and thus the effective priority date for this subject matter is January 10, 2001, the filing date of PCT/EP01/00307. While dependent, as applicants correctly point out, claims 21, 24-25, 27-28, 30-31 and 33-34 may also be re-written in independent form, and are to be interpreted as such for examination purposes, each individually examined on its own merits. Thus, while the reference is not eligible prior art against the broad independent claims 1, 7, 13, 18 and 20, it is properly applicable to the newly-added subject matter of claims 21-35.

Dependent claims are simply a short-hand way of providing the limitations of independent claims. In other words, if each of claims 21, 24-25, 27-28, 30-31 and 33-34 were written as independent claims, they would be rejected under this statute with this reference. The subject matter of independent claim 20 finds support in the parent application 09/154,646 filed September 17, 1998, which date is prior to the filing date and effective 102(e) date of the reference. However, the subject matter of claims 21-35 does not garner such priority, as stated on the first page of this and previous Office actions. Therefore, the newly-provided subject matter of claims 21-35 *must* be addressed separately from all other claims. In the instant case, the intervening reference to Wang teaches the newly presented subject matter as a whole, as applicable to claims 21, 24-25, 27-28, 30-31 and 33-34, and thus it *must* be applied to these claims, regardless of whether they are in dependent, or independent, form.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 13-17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gellman et al. The reference and rejection are incorporated as cited in a previous Office action.

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Applicant's arguments filed April 26, 2004, have been fully considered but they are not persuasive. Applicant has essentially incorporated their arguments from the previous response, and thus the rejection is maintained for the reasons of record.

Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hand et al., taken as cited above, in view of Schommer et al. (US PAT 5,887,749). The reference and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed April 26, 2004, have been fully considered but they are not persuasive. Applicant has essentially incorporated their arguments from the previous response, and thus the rejection is maintained for the reasons of record.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

i) Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 09/154,646.

ii) Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 10/052,949.

iii) Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of copending Application No. 10/037,941

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Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both directed to pet food chew products (and methods of use) of various sizes, with the same density properties and overlapping ingredients of denatured proteins and starches, insoluble fibers, etc.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


KEITH HENDRICKS
PRIMARY EXAMINER